

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF APPEALS

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**BRIEF ON APPEAL**

In re the application of Jeffry A. Pegg

Filed: December 15, 2003

Serial No.: 10/734,883

Group Art Unit: 3711

Examiner: Hunter, A.

For: Vertically Mass Balanced Putter

JACK A. KANZ  
for Appellant



## TABLE OF CONTENTS

<b>TABLE OF AUTHORITIES .....</b>	<b>iii</b>
<b>REAL PARTY IN INTEREST .....</b>	<b>1</b>
<b>RELATED APPEALS AND INTERFERENCES.....</b>	<b>2</b>
<b>STATUS OF THE CLAIMS.....</b>	<b>2</b>
<b>STATUS OF AMENDMENTS .....</b>	<b>2</b>
<b>SUMMARY OF THE INVENTION.....</b>	<b>2</b>
<b>THE ISSUES .....</b>	<b>3</b>
<b>GROUPING OF THE CLAIMS.....</b>	<b>5</b>
<b>THE REFERENCE.....</b>	<b>5</b>
<b>THE REJECTIONS.....</b>	<b>5</b>
<b>ARGUMENT AND AUTHORITIES .....</b>	<b>6</b>
<b>The §102(a) Rejections .....</b>	<b>6</b>
<b>ISSUE A. Does Pegg '956 disclose each and every element of the invention defined in Claim 1 with each such element arranged as in the claim? .....</b>	<b>7</b>
<b>ISSUE B. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 1?.....</b>	<b>9</b>
<b>ISSUE C. Does Pegg '956 disclose each and every element of the invention defined in Claim 2 with each such element arranged as in the claim? .....</b>	<b>11</b>
<b>ISSUE D. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 2? .....</b>	<b>12</b>
<b>ISSUE E. Does Pegg '956 disclose each and every element of the invention defined in Claim 3 with each such element arranged as in the claim? .....</b>	<b>12</b>
<b>ISSUE F. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 3?.....</b>	<b>13</b>
<b>ISSUE G. Does Pegg '956 disclose each and every element of the invention defined in Claim 4 with each such element arranged as in the claim? .....</b>	<b>14</b>
<b>ISSUE H. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 4?.....</b>	<b>15</b>

<b>ISSUE I. Does Pegg '956 disclose each and every element of the invention defined in Claim 5 with each such element arranged as in the claim? .....</b>	<b>15</b>
<b>ISSUE J. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 5?.....</b>	<b>16</b>
<b>ISSUE K. Does Pegg '956 disclose each and every element of the invention defined in Claim 6 with each such element arranged as in the claim? .....</b>	<b>9</b>
<b>ISSUE L. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 6?.....</b>	<b>10</b>
<b>ISSUE M. Does Pegg '956 disclose each and every element of the invention defined in Claim 7 with each such element arranged as in the claim? .....</b>	<b>17</b>
<b>ISSUE N. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 7?.....</b>	<b>18</b>
<b>ISSUE O. Does Pegg '956 disclose each and every element of the invention defined in Claim 8 with each such element arranged as in the claim? .....</b>	<b>18</b>
<b>ISSUE P. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 8?.....</b>	<b>19</b>
<b>The §102(e) Rejections.....</b>	<b>20</b>
<b>ISSUE Q. Can claims in a patent application be rejected under 35 USC 102(e) when the inventor in the application is the same inventor in the reference?.....</b>	<b>20</b>
<b>CONCLUSION.....</b>	<b>21</b>
<b>APPENDIX I .....</b>	<b>A1-A3</b>
<b>APPENDIX II.....</b>	<b>A4-A7</b>

## TABLE OF AUTHORITIES

### CASES

<i>Akzo N.V. v. U.S. International Trade Commission</i> , 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), <i>cert. denied</i> 482 US 909 (1987) .....	7
<i>Connell v. Sears, Roebuck &amp; Co.</i> , 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983) .....	6
<i>Kalman v. Kimberly-Clark Corp.</i> , 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), <i>cert. denied</i> 465 US 1026 (1984) .....	7, 20
<i>Lindemann Maschinenfabrik GMBH v. American Hoist &amp; Derrick Co.</i> , 1730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984) .....	6
<i>McCullough Tool Co. v. Well Surveys, Inc.</i> , 343 F.2d 381, 145 USPQ 6 (10 <sup>th</sup> Cir. 1985) .....	6
<i>PPG Industries, Inc. v. Guardian Industries, Corp.</i> , 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996) .....	20
<i>Riverwood Int'l Corp. v. R.A. Jones &amp; Co.</i> 66 USPQ2d 1331 (Fed. Cir. 2003) .....	21
<i>SRI Int'l v. Matsushita Elec. Corp. of Am.</i> , 775 F.2d 1107, 1125 227 USPQ 577, 588-89 (Fed. Cir. 1985) ( <i>in banc</i> ) .....	20
<i>SSIH Equip. S.A. v. U.S. Int. Trade Comm'n</i> , 718 F.2d 365, 218 USPQ 678 (Fed. Cir. 1983) .....	6, 7
<i>W.L. Gore &amp; Associates, Inc. v. Garlock, Inc.</i> , 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) .....	7



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APPEAL NO.: \_\_\_\_\_

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Art Unit: 3711

Examiner: Hunter, A.

Title: Vertically Mass Balanced Putter

**BRIEF ON APPEAL**

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

This is an appeal from the final rejection of Claims 1-8 in the above-identified application.

**REAL PARTY IN INTEREST**

Jeffry A. Pegg, the inventor.

## **RELATED APPEALS AND INTERFERENCES**

None

## **STATUS OF THE CLAIMS**

No claims have been allowed. Claims 1-8 have been rejected under 35 USC 102(a) and 35 USC 102(e). The claims on appeal are reproduced in Appendix I.

## **STATUS OF AMENDMENTS**

An amendment was filed September 13, 2005, which merely corrects minor typographical errors in the specification. Appellant has not been informed regarding entry of this amendment. For convenience of the Board, a copy of the September 13, 2005, amendment is attached as Appendix II. No other amendments have been proposed.

## **SUMMARY OF THE INVENTION**

This invention relates to golf clubs. More particularly, it relates to putters which are weighted and assembled with their components arranged so that the vertical center of mass of the putter (head, shaft and grip) lies within the horizontal length of a defined preferred striking surface of the face of the putter head. Thus the mass of the putter is substantially balanced with respect to the vertical axis of the putter head.

The general structure of the putter of the invention is illustrated in the drawing as a putter which has a head 10, a shaft 20 and a grip 28. The head 10 defines a horizontal axis and has a bottom face 12, a top face 13 and a striking face 11 which extends in a substantially vertical plane from the bottom face 12 to the top face 13. The shaft 20 extends from the top face 13 of the head at an angle of about 8° to 25° from

vertical. Grip 28 is positioned at the end of the shaft 20 opposite the head 10. As defined by Claim 1, the mass of the putter is substantially balanced about a vertical line extending through the horizontal mid-point of the putter head. The striking face 11 extends in a substantially vertical plane substantially parallel with the horizontal axis. A preferred striking area is positioned on said striking surface which extends approximately one inch in each direction horizontally from the horizontal mid-point of the putter head. The shaft 20 extends from the top face 13 at an angle of from about 8° to about 25° from vertical and is aligned so that the mass of the putter (including head 10, shaft 20 and grip 28) lies within the horizontal length of the defined preferred striking area. As more specifically defined in Claim 6, the shaft 20 extends from the top face 13 at a position between said horizontal mid-point and the toe end of the putter head 10.

The unique structure defined by the claims provides a putter (including head, shaft and grip) in which the mass is uniformly balanced about the horizontal mid-point of the putter head. Accordingly, when the putter is stroked in the desired pendulum motion, the tendency for the putter head to yaw is virtually eliminated, resulting in a uniform stroke motion in which the striking face of the putter remains perpendicular to the direction of travel throughout the entire swing. By maintaining the vertical center of mass substantially at the horizontal mid-point of the striking surface, unintentional yaw is reduced and the striking face remains perpendicular to the direction of travel throughout the entire swing.

### **THE ISSUES**

A. Does Pegg '956 disclose each and every element of the invention defined in Claim 1 with each such element arranged as in the claim?

B. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 1?

C. Does Pegg '956 disclose each and every element of the invention defined in Claim 2 with each such element arranged as in the claim?

D. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 2?

E. Does Pegg '956 disclose each and every element of the invention defined in Claim 3 with each such element arranged as in the claim?

F. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 3?

G. Does Pegg '956 disclose each and every element of the invention defined in Claim 4 with each such element arranged as in the claim?

H. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 4?

I. Does Pegg '956 disclose each and every element of the invention defined in Claim 5 with each such element arranged as in the claim?

J. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 5?

K. Does Pegg '956 disclose each and every element of the invention defined in Claim 6 with each such element arranged as in the claim?

L. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 6?

M. Does Pegg '956 disclose each and every element of the invention defined in Claim 7 with each such element arranged as in the claim?



N. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 7?

O. Does Pegg '956 disclose each and every element of the invention defined in Claim 8 with each such element arranged as in the claim?

P. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 8?

Q. Can claims in a patent application be rejected under 35 USC 102(e) when the inventor in the application is the same inventor in the reference?

### **GROUPING OF THE CLAIMS**

The rejected claims do not stand or fall together. With respect to the rejections under 35 USC 102(a), separate arguments for patentability are advanced in support of each of Claims 1-8.

### **THE REFERENCE**

U.S. Patent No. 6,634,956 to Pegg, the inventor named in the present application.

### **THE REJECTIONS**

Claims 1-8 have been rejected under 35 USC 102(a) and 35 USC 102(e) as anticipated by Pegg, the Examiner alleging:

“Regarding claims 1 and 6, Pegg discloses a putter comprising: (a) a putter head having a first mass and defining a bottom face, a top face and a striking face which defines a horizontal axis and which extends in a substantially vertical plane from said bottom face toward said top face and extends at least about four inches in a plane substantially parallel with said horizontal axis to inherently define a preferred striking area approximately centrally located on said striking face and extending a distance of approximately

one inch in each direction horizontally from the horizontal mid-point of said striking face; and (b) a shaft having a second mass and extending from the top face of said putter at an angle of from about 10° to about 25° from vertical with respect to said horizontal axis supporting a grip on the end thereof remote from said putter head and aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area (See Figures 1 and 2 and Column 2, lines 53 through 59).

Regarding claim 2, Pegg shows the putter head being geometrically symmetrical about its vertical axis (See Figure 2).

Regarding claim 3, Pegg shows the shaft extending from the top face at a point between the toe end of the putter head and the vertical axis of the putterhead (See Figure 2).

Regarding claim 4 and 7, Pegg shows the putter head including a marker on the top face thereof which identifies the horizontal mid-point of the striking face (See Figure 2).

Regarding claim 5, Pegg shows the mark extending in opposite directions from the geometric center of the putter head (See Figure 2).

Regarding claim 8, Pegg shows the marker equally visible on the opposite sides of the shaft when the marker is aligned for striking a ball and the striking face is aligned perpendicular to the desired direction of travel of the ball (See Figure 2)."

## **ARGUMENT AND AUTHORITIES**

### **The §102(a) Rejections**

It has long been settled that an anticipation rejection under 35 USC 102 requires disclosure in a single prior art reference of each and every element of the claimed invention arranged as in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. U.S. Int. Trade Comm'n*, 718 F.2d 365, 218 USPQ 678 (Fed. Cir. 1983); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 1730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). In order to support an anticipation rejection under §102(a) it is also necessary that the prior art reference teach in a single structural combination all elements of the invention and the elements must perform substantially the same work the same way in both the prior art reference and the claimed invention. *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381, 145 USPQ 6 (10<sup>th</sup> Cir. 1985).

An anticipation rejection under §102 further requires that each claim element must function in the reference in the manner set forth in the claims. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), *cert. denied* 482 US 909 (1987); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1544, 220 USPQ 303, 313 (Fed. Cir. 1983). In determining anticipation, the elements of the claim must be identified and their meaning determined in light of the specification. These elements should then be compared to corresponding elements disclosed in the allegedly anticipating references. *SSIH Equipment S.A. v. U.S. Int. Trade Comm'n*, 218 USPQ 678 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), *cert. denied* 465 US 1026 (1984).

**ISSUE A. Does Pegg '956 disclose each and every element of the invention defined in Claim 1 with each such element arranged as in the claim?**

Claim 1 recites:

1. A putter comprising:
  - (a) a putter head having a first mass and defining a bottom face, a top face and a striking face which defines a horizontal axis and which extends in a substantially vertical plane from said bottom face toward said top face and extends at least about four inches in a plane substantially parallel with said horizontal axis to define a preferred striking area approximately centrally located on said striking face and extending a distance of approximately one inch in each direction horizontally from the horizontal mid-point of said striking face; and
  - (b) a shaft having a second mass and extending from the top face of said putter at an angle of from about 8° to about 25° from vertical with respect to said

horizontal axis supporting a grip on the end thereof remote from said putter head and aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area.

In rejecting Claim 1 (and Claim 6), the Examiner alleges:

“...Pegg discloses a putter comprising: (a) a putter head having a first mass and defining a bottom face, a top face and a striking face which defines a horizontal axis and which extends in a substantially vertical plane from said bottom face toward said top face and extends at least about four inches in a plane substantially parallel with said horizontal axis to inherently define a preferred striking area approximately centrally located on said striking face and extending a distance of approximately one inch in each direction horizontally from the horizontal mid-point of said striking face; and (b) a shaft having a second mass and extending from the top face of said putter at an angle of from about 10° to about 25° from vertical with respect to said horizontal axis supporting a grip on the end thereof remote from said putter head and aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area (See Figures 1 and 2 and Column 2, lines 53 through 59).”

The Examiner is in error.

Claim 1 specifically requires the shaft and grip to be “aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area.” No such shaft and grip arrangement is shown or even remotely suggested in Pegg '956. Apparently, the Examiner has confused (and attempted to equate) “free standing” as disclosed in Pegg '956 with “vertically mass balanced” as disclosed and claimed in the present application. Pegg '956 discloses and claims a free standing putter in which specific parameters such as mass and shape of the putter head are specifically defined. The specific parameters defined are necessary in order to permit the putter to be free standing *regardless* of the location of its vertical center of mass. In contradistinction, Claim 1 specifically defines the relationship between the putter head and the shaft as “aligned so that the vertical center of mass lies within the horizontal length of said preferred striking area.” The “vertical center of mass” and “preferred striking area,” as used in Claim 1, are neither defined, disclosed nor recognized in Pegg

'956. Accordingly, nothing in the disclosure of Pegg '956 can be described as “a shaft...aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area” as specifically defined by Claim 1. Since this element of Claim 1 cannot be found in the reference, it cannot be “arranged as in the claim” and clearly cannot “perform substantially the same work the same way” in both the reference and Claim 1. Accordingly, nothing in Pegg '956 can be used to support a §102(a) anticipation rejection of Claim 1.

**ISSUE B. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 1?**

As noted above, the shaft must be “aligned so that the vertical center of mass of the putter lies within the horizontal length of the preferred striking area.” Therefore, an essential function of the shaft is to maintain the vertical center of mass of the entire putter (head, shaft and grip) within the horizontal length of the preferred striking area. No such function is shown or even remotely suggested in Pegg '956. In fact, this relationship cannot be found in Pegg '956 because the entire mass of shaft and putter head is on the heel side of the head. Since maintaining the defined vertical mass balance of the putter is an essential function of the shaft, and since this function cannot be found in the reference, Claim 1 cannot be anticipated by Pegg '956 as required under 35 USC 102(a).

**ISSUE K. Does Pegg '956 disclose each and every element of the invention defined in Claim 6 with each such element arranged as in the claim?**

In addition to the specific requirement that the putter head and shaft be arranged and weighted “to align the vertical center of mass thereof within the horizontal length of said striking area” (as in Claim 1), Claim 6 further requires

“(b) a shaft extending from said top face of said putter at a position between said horizontal mid-point and said toe...”

No such specific structure is shown or even remotely suggested in Pegg '956. Instead, Fig. 2 of Pegg '956 (relied on by the Examiner) shows the shaft extending from the top of the putter head between the horizontal mid-point of the putter head and the heel of the putter head. Since Claim 6 specifically requires “a shaft extending from said top face of said putter head at a position between said horizontal mid-point and said toe...” and the reference only shows a shaft extending from the putter head top surface between the horizontal mid-point and the heel, the claimed element cannot be found in the reference “arranged as in the claim” and clearly cannot “perform substantially the same work in the same way” in both the reference and Claim 6. Accordingly, nothing found in Pegg '956 can be used to support a 102(a) anticipation rejection of Claim 6.

**ISSUE L. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 6?**

Claim 6 specifically requires “a shaft extending from the top face...at a position between said horizontal mid-point and said toe...arranged and weighted to align the vertical center of mass...[of the putter]...within the horizontal length of said preferred striking area.” Thus an essential function of the shaft is to maintain the vertical center of mass of the entire putter (head, shaft and grip) within the horizontal length of the preferred striking area. In Claim 6, the vertical center of mass of the shaft and grip is shifted toward the toe by mounting the shaft between the horizontal mid-point and the

toe. However, the mass of the shaft and grip is distributed over the mid-point of the striking surface because the shaft extends from the toe portion of the head toward the heel. Since maintaining the defined vertical mass balance of the putter is an essential function of the toe-mounted shaft, and since this function (nor this structure) cannot be found in the reference, Claim 6 cannot be anticipated by Pegg '956 as required under 35 USC 102(a).

**ISSUE C. Does Pegg '956 disclose each and every element of the invention defined in Claim 2 with each such element arranged as in the claim?**

Claim 2 recites:

2. A putter as defined in Claim 1 wherein said putter head is geometrically symmetrical about its vertical axis.

In rejecting Claim 2, the Examiner alleges:

“Pegg shows the putter head being geometrically symmetrical about its vertical axis (see Figure 2).”

Admittedly, Fig. 2 of Pegg '956 shows a putter head symmetrical about its vertical axis. However, Claim 2 is dependent from Claim 1 and thus includes all the limitations of Claim 1. Since Pegg '956 fails to show or remotely suggest the limitations of Claim 1 (from which Claim 2 depends) as demonstrated hereinabove, Pegg '956 simply cannot disclose a putter which includes “a shaft...aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area” and a putter head which is also symmetrical about its vertical axis as defined in Claim 2. Since these elements of Claim 2 cannot be found in the reference, they cannot be “arranged as in the claim” and clearly cannot “perform substantially the same work the same way” in

both the reference and Claim 2. Accordingly, nothing in Pegg '956 can be used to support a 102(a) anticipation rejection of Claim 2.

**ISSUE D. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 2?**

As noted above, the shaft must be “aligned so that the vertical center of mass of the putter lies within the horizontal length of the preferred striking area” and the putter head must be geometrically symmetrical about its vertical axis. Therefore, an essential function of the arrangement of these elements is to maintain the vertical mass of the entire putter (head, shaft and grip) within the horizontal length of the preferred striking area. No such function is shown or even remotely suggested in Pegg '956. Since maintaining the defined vertical mass balance of the putter is an essential function of the defined elements, and since this function cannot be found in the reference, Claim 2 cannot be anticipated by Pegg '956 as required under 35 USC 102(a).

**ISSUE E. Does Pegg '956 disclose each and every element of the invention defined in Claim 3 with each such element arranged as in the claim?**

Claim 3 recites:

3. A putter head as defined in Claim 2 wherein said shaft extends from said top face at a point between the toe end of said putter head and the vertical axis of said putter head.

In rejecting Claim 3, the Examiner alleges:

“Pegg shows the shaft extending from the top face at a point between the toe end of the putter head and the vertical axis of the putterhead (See Figure 2).”



As noted above, the Examiner is clearly in error. Fig. 2 of Pegg '956 shows shaft 30 extending from the top face 13 of the putter head at a point between the vertical axis of the putter head and the heel of the putter head as in conventional putters and *opposite* the location specified in Claim 3. Furthermore, Claim 3 is ultimately dependent from Claim 2 which is dependent from Claim 1 and thus includes all the limitations of Claim 1 and Claim 2. Nothing in the disclosure of Pegg '956 can be described as a shaft which "extends from the top face at a point between the toe end of the putter head and the vertical axis of the putter head" which is "aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area" as specifically defined by Claim 3. Since this element of Claim 3 cannot be found in the reference, it cannot be "arranged as in the claim" and clearly cannot "perform substantially the same work the same way" in both the reference and Claim 3. Accordingly, nothing in Pegg '956 can be used to support a §102(a) anticipation rejection of Claim 3.

**ISSUE F. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 3?**

As noted above, mounting the shaft between the toe end and the horizontal mid-point of the putter head (and angled toward the heel) functions to maintain the center of mass substantially at the mid-point of the preferred striking surface. No such function is shown or even remotely suggested in Pegg '956. In fact, this relationship cannot be found in Pegg '956 because the entire mass of shaft and putter head is on the heel side of the head. Since maintaining the defined vertical mass balance of the putter is an essential function of the shaft, and since this function cannot be found in the reference, Claim 3 cannot be anticipated by Pegg '956 as required under 35 USC 102(a).

**ISSUE G. Does Pegg '956 disclose each and every element of the invention defined in Claim 4 with each such element arranged as in the claim?**

Claim 4 recites:

4. A putter as defined in Claim 3 wherein said putter head includes a marker on said top face thereof which identifies the horizontal mid-point of said striking face.

In rejecting Claim 4 the Examiner alleges:

“Pegg shows the putter head including a marker on the top face thereof which identifies the horizontal mid-point of the striking face (See Figure 2).”

Admittedly, Fig. 2 of Pegg '956 illustrates a marker on the top face of the putter head which identifies the horizontal mid-point of the striking face. However, Claim 4 is dependent from Claims 3, 2 and 1 and thus includes all the limitations of Claims 1, 2 and 3. The marker of Claim 4, therefore, must be between the heel of the putter head and the point on the top surface of the head at which the shaft is attached. In Pegg '956 the shaft is attached on the opposite side of the marker. Since Claim 3 specifically requires the shaft to extend from the putter head at a point between the toe and the mid-point, and Claim 4 further requires a marker at the mid-point, Claim 4 specifically requires a putter (with all the limitations of Claim 1 and) which has the shaft attached to the head at a point between the toe and a mid-point on which there is a marker. No such structure is shown or even remotely suggested in Pegg '956. Since the specific elements specified in Claim 4 cannot be found in the reference, they cannot be “arranged as in the claim” and clearly cannot “perform substantially the same work the same way” in both the reference and Claim 4. Accordingly, nothing in Pegg '956 can be used to support a 102(a) anticipation rejection of Claim 4.

**ISSUE H. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 4?**

As noted above, the shaft must extend from the head “at a point between the toe end of the putter head and the vertical axis of said putter head”; must be “aligned so that the vertical center of mass of the putter lies within the horizontal length of the preferred striking area”; and the putter head must have “a marker on said top face...which identifies the horizontal mid-point of said striking face.” An essential function of the arrangement of these elements is to maintain the vertical mass of the entire putter (head, shaft and grip) within the horizontal length of the preferred striking area, the mid-point of which is identified by the marker. No such function is shown or even remotely suggested in Pegg '956. Since maintaining the defined vertical mass balance of the putter near the marker mid-point is an essential function of the defined elements, and since this function cannot be found in the reference, Claim 4 cannot be anticipated by Pegg '956 as required under 35 USC 102(a).

**ISSUE I. Does Pegg '956 disclose each and every element of the invention defined in Claim 5 with each such element arranged as in the claim?**

Claim 5 recites:

5. A putter as defined in Claim 4 wherein said mark extends in opposite directions from the geometric center of said putter head.

In rejecting Claim 5 the Examiner alleges:

“Pegg shows the mark extending in opposite directions from the geometric center of the putter head (See Figure 2).”

Appellant fails to comprehend the significance of this comment. Claim 5 is dependent from Claim 4 which includes all the limitations of Claims 3, 2 and 1 from which it

ultimately depends. Since the sole reference cited fails to disclose the specific limitations of Claims 1, 2, 3 and 4, all as set forth hereinabove, that same reference is wholly incapable of showing or suggesting the limitations of Claim 5. Furthermore, the claim requires the marker to extend “in opposite directions from the geometric center” of the putter head (see Fig. 1). In Pegg '956 the marker extends across the entire top surface of the putter head. The purpose of having the markers extend “in opposite directions from the geometric center” is to permit the opposite ends of the marker to be visible to the user when the shaft (attached toward the toe) blocks the user’s view of the geometric center of the top face of the club. This arrangement of components is unique to the claimed invention. Since this unique arrangement of elements cannot be found in the reference, the elements cannot be “arranged as in the claim” and clearly cannot “perform substantially the same work the same way” in both the reference and Claim 5. Accordingly, nothing in Pegg '956 can be used to support a §102(a) anticipation rejection of Claim 5.

**ISSUE J. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 5?**

As noted above, the shaft must extend from the head “at a point between the toe end of the putter head and the vertical axis of said putter head”; must be “aligned so that the vertical center of mass of the putter lies within the horizontal length of the preferred striking area”; and the putter head must have “a marker on said top face...which identifies the horizontal mid-point of said striking face.” An essential function of the arrangement of these elements is to use the shaft (in corporation with the marker) to align the face of the club. This is accomplished by aligning the shaft so that the opposite ends of the marker (extending from the geometric center of the putter

head) be visible on opposite sides of the shaft. No such function is shown or even remotely suggested in Pegg '956. Since using the ends of the marker (in cooperation with the shaft) to align the face of the club is an essential function of the defined elements, and since this function cannot be found in the reference, Claim 5 cannot be anticipated by Pegg '956 as required under 35 USC 102(a).

**ISSUE M. Does Pegg '956 disclose each and every element of the invention defined in Claim 7 with each such element arranged as in the claim?**

Claim 7 recites:

7. A putter as defined in Claim 6 wherein said putter head includes a marker on the top face thereof which identifies the horizontal center of mass of said putter.

In rejecting Claim 7 the Examiner alleges:

“Pegg shows the putterhead including a marker on the top face thereof which identifies the horizontal mid-point of the striking face (see Figure 2).”

The Examiner is again mistaken. The claim specifies that the marker identifies “the horizontal center of mass” of the putter. Nowhere does Pegg show, discuss or otherwise identify a horizontal *center of mass* as defined by Claim 7.<sup>1</sup> Since this element of Claim 7 cannot be found in the reference, it cannot be “arranged as in the claim” and clearly cannot “perform substantially the same work the same way” in both the reference and Claim 7. Accordingly, nothing in Pegg '956 can be used to support a §102(a) anticipation rejection of Claim 7.

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<sup>1</sup> Note that the Examiner alleges that Pegg '956 shows a marker “which identifies the horizontal *mid-point of the striking face*,” not the horizontal *center of mass* as claimed. (emphasis added)

**ISSUE N. Does each and every element shown in Pegg '956 function in the reference in the same manner as it functions in the Claim 7?**

As noted above, the marker of Claim 7 must identify the horizontal center of mass of the putter. The function of this marker is to identify the horizontal center of mass of the entire putter (head, shaft and grip). No such function is shown or even remotely suggested in Pegg '956. In fact, Pegg '956 does not even attempt to identify the center of mass. Since identifying and marking the horizontal center of mass of the putter is an essential function of the marker, and since this function cannot be found in the reference, Claim 7 cannot be anticipated by Pegg '956 as required by 35 USC 102(a).

**ISSUE O. Does Pegg '956 disclose each and every element of the invention defined in Claim 8 with each such element arranged as in the claim?**

Claim 8 recites:

8. A putter as defined in Claim 7 wherein said marker is equally visible on opposite sides of said shaft when the marker is aligned with a ball to be struck and said striking face is aligned perpendicular to the desired direction of travel of said ball.

In rejecting Claim 8 the Examiner alleges:

“Pegg shows the marker equally visible on the opposite sides of the shaft when the marker is aligned for striking a ball and the striking face is aligned perpendicular to the desired direction of travel of the ball (See Figure 2).”

Again, the Examiner is in error. Fig. 2 of Pegg '956 clearly shows the shaft 30 between the heel and the horizontal mid-point of the putter head. Since the shaft is also inclined toward the heel, the marker 16 identifies only the horizontal mid-point of the putter head. The horizontal center of mass (of the Pegg '956 putter) is at an undetermined

point between marker 16 and the heel of the putter head because the entire mass of the shaft 30 and grip 31 are displaced on the heel side of marker 16. In Claim 8, the marker identifies the horizontal center of *mass*. Furthermore, Claim 8 specifically requires the elements of the putter be arranged so that the marker is “equally visible on opposite sides of the shaft when the marker is aligned with a ball to be struck...” This condition can occur only when the shaft is attached to the head at a position between the toe of the head and the marker. Since the shaft is inclined toward the heel, the shaft must obstruct the user’s view of the center of the top face between the opposite ends of the markers. This allows the user to use the markers (in cooperation with the shaft) to properly align the putter face. Nowhere does Pegg ’956 show or suggest such an apparatus. Since this arrangement of elements cannot be found in the reference, they cannot be “arranged as in the claim” and clearly cannot “perform substantially the same work the same way” in both the reference and Claim 8. Accordingly, nothing in Pegg ’956 can be used to support a §102(a) anticipation rejection of Claim 8.

**ISSUE P. Does each and every element shown in Pegg ’956 function in the reference in the same manner as it functions in the Claim 8?**

As noted above, the shaft must be mounted between the toe and the horizontal mid-point in order to obstruct the user’s view of the center of the marker. By positioning the marker so as to be “visible on opposite sides of the shaft,” the marker (in cooperation with the shaft) functions to align the face of the putter with the desired direction of travel of the ball. No such function is shown or even remotely suggested in Pegg ’956. In fact, this function cannot be found in Pegg ’956 because the shaft is on the heel side of the marker. Since cooperating with the shaft to align the putter face is an essential function of the marker, and since this function cannot be found in the

reference, Claim 8 cannot be anticipated by Pegg '956 as required under 35 USC 102(a).

The cited reference shows a free standing putter. It does not show the vertically mass balanced structure claimed and the device of the reference cannot perform the functions of the invention. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make that anticipating subject matter." *PPG Industries, Inc. v. Guardian Industries, Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). Since the reference obviously fails to show the unique features claimed, it is not apparent how the sole reference can teach one skilled in the art to make the structure claimed.

In order to support a §102 rejection, there must be a complete "identity of invention" *Kalman v. Kimberly-Clark Corp.* 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984), *overruled in part on another ground*, *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1125 227 USPQ 577, 588-89 (Fed. Cir. 1985) (*in banc*) Since Pegg '956 fails to disclose structure recited in Claims 1-8, and since the structure disclosed by the sole reference cannot perform the same work in the same way as putters defined by Claims 1-8, the rejection of Claims 1-8 as anticipated by Pegg '956 cannot be supported by 35 USC 102(a). Accordingly, the rejections must be reversed.

#### **The §102(e) Rejections**

**ISSUE Q. Can claims in a patent application be rejected under 35 USC 102(e) when the inventor in the application is the same inventor in the reference?**

Sec. 102 states, in pertinent part;

"A person shall be entitled to a patent unless –



...  
(e) the invention was described in (1) an application for patent, published under section 122(b), *by another* filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent *by another* filed in the United States before the invention by the applicant for patent..." (emphasis added)

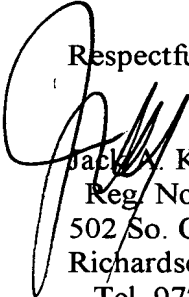
It is believed elementary that the statutory proscription of Sec. 102(e) applies only where the inventor in the application and the inventor in the reference are different inventive entities (See MPEP 706.02(a) II B. and MPEP 706.02(f)). In order to apply a reference under 35 U.S.C. 102(e), the inventive entity of the application must be different than that of the reference. *Riverwood Int'l Corp. v. R.A. Jones & Co.* 66 USPQ2d 1331 (Fed. Cir. 2003). The record clearly establishes that the inventor in the present application and the inventor in the sole reference are one and the same person – Jeffry A. Pegg. Obviously, Pegg '956 cannot be relied on to support a rejection of the claims in the present application under the provisions of 35 USC 102(e).

### **CONCLUSION**

Appellant submits that Claims 1-8 have been erroneously rejected for the reasons set forth hereinabove. Accordingly, reversal of the rejection is respectfully requested.

Our check in the amount of \$250.00 to cover the fee for filing this Brief on Appeal is submitted herewith.

Respectfully submitted,



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ATTORNEY FOR APPELLANT

September 15, 2005

**APPENDIX I****WHAT IS CLAIMED:**

1. A putter comprising:
  - (a) a putter head having a first mass and defining a bottom face, a top face and a striking face which defines a horizontal axis and which extends in a substantially vertical plane from said bottom face toward said top face and extends at least about four inches in a plane substantially parallel with said horizontal axis to define a preferred striking area approximately centrally located on said striking face and extending a distance of approximately one inch in each direction horizontally from the horizontal mid-point of said striking face; and
  - (b) a shaft having a second mass and extending from the top face of said putter at an angle of from about 8° to about 25° from vertical with respect to said horizontal axis supporting a grip on the end thereof remote from said putter head and aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area.
2. A putter as defined in Claim 1 wherein said putter head is geometrically symmetrical about its vertical axis.
3. A putter head as defined in Claim 2 wherein said shaft extends from said top face at a point between the toe end of said putter head and the vertical axis of said putter head.

4. A putter as defined in Claim 3 wherein said putter head includes a marker on said top face thereof which identifies the horizontal midpoint of said striking face.

5. A putter as defined in Claim 4 wherein said mark extends in opposite directions from the geometric center of said putter head.

6. A putter comprising:

- (a) a putter head having a toe end, a heel end, a bottom face, a top face and a striking face which defines a preferred striking area approximately centrally located on said striking face and extending approximately one inch in each direction horizontally from the horizontal midpoint of said striking face;
- (b) a shaft extending from said top face of said putter head at a position between said horizontal midpoint and said toe end at an angle of from about 8° to about 25° from vertical wherein said putter head and said shaft are arranged and weighted to align the vertical center of mass thereof within the horizontal length of said preferred striking area.

7. A putter as defined in Claim 6 wherein said putter head includes a marker on the top face thereof which identifies the horizontal center of mass of said putter.

8. A putter as defined in Claim 7 wherein said marker is equally visible on opposite sides of said shaft when the marker is aligned a ball to be struck and said striking face is aligned perpendicular to the desired direction of travel of said ball.

**APPENDIX II****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the application of Jeffry A. Pegg

Filed: December 15, 2003

Serial No: 10/734,883

Art Unit: 3711

Examiner: Hunter, Jr., A. A.

Title: Vertically Mass Balanced Putter

I hereby certify that this correspondence is being deposited with the United States Postal Service on this date as first class mail, proper postage prepaid, in an envelope addressed to the Commissioner of Patents and Trademarks as specified by 37 CFR §1.8.

DEBORAH A. FOX  
Printed name

Deborah A. Fox 13 Sep 05  
Signature Date

**AMENDMENT**

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

Please amend the above-identified application as follows:

**SPECIFICATION AMENDMENT:**

[010] The embodiment of the putter illustrated in the drawing comprises a putter head 10 supported on one end of a conventional shaft 20 having a grip ~~21~~ 28 on the opposite end thereof. So long as the distributed mass of the shaft and grip comply with the mass distribution specified herein, these components may be conventional. Accordingly, the putter of Figs 2 and 3 is illustrated without the central portion of the shaft 20.

[016] In accordance with this invention, the components (head 10, shaft 20, grip ~~21~~ 28) are arranged and assembled to distribute the mass of the assembled construction equally on opposite sides of a vertical plane which is normal to and intersects the axial length of the preferred striking area 17 of the striking face 11. This mass distribution may be accomplished by various means such as shaping or weighting the toe or heel of the putter head to compensate for the mass of the shaft and grip. In the preferred embodiment, however, the head 10 is of substantially uniform density and symmetrically weighted about its vertical axis. The head 10 does not, of course, need to be a simple blade shape as illustrated but may be otherwise shaped and/or include a striking plate or the like. In the preferred embodiment, however, such shaping, *etc.*, should be arranged to maintain the mass of the putter head substantially equally distributed on opposite sides of the vertical axis of the head 10. To maintain the mass of the complete putter equally distributed on opposite sides of the horizontal midpoint of the striking face, the shaft 20 is attached to the head 10 at point between the horizontal midpoint of the head and the toe end of the putter as illustrated in the drawing. Displacement of the attachment point of the shaft 20 toward the toe end is necessary to compensate for the combined mass of the shaft 20 and grip ~~21~~ 28 because the shaft 20 does not extend vertically from the putter head 10. Instead, the shaft 20 is inclined from vertical toward the heel of the head 10 to allow the golfer to address the ball from a

point removed from the location of the ball. Thus the displacement distance of shaft 20 toward the toe end of the head depends on the mass of the shaft and grip, the length of the shaft and the angle at which the shaft deviates from vertical.

[017] Putter shafts 20 are ordinarily between about thirty-two (32) inches and thirty-eight (38) inches in length. The combined mass of the shaft and grip is usually less than about five (5) ounces. The angle at which the shaft 20 deviates from vertical may vary from about 8° to about 25°. Accordingly, when the mass of the head 10 is uniformly distributed on opposite sides of the vertical axis, the mass of the shaft and grip must be likewise substantially distributed in opposite sides of the vertical axis. Such mass distribution is conveniently achieved by extending the shaft 20 from the top face 13 at a point between the vertical axis of the head 10 and the toe end. Depending on the mass of the shaft 20 and grip 24 28, the length of the shaft 20 and the angle at which shaft 20 deviates from vertical, the point at which the shaft 20 joins the head 10 may be displaced toward the toe end from less than one-fourth (1/4) inch to as much as two (2) inches or more.

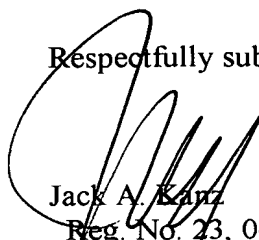
[020] In accordance with the invention ~~marks~~ markers 25, 26 are positioned on top face 13 to extend from the back face and front face, respectively, of the putter head. Markers 25, 26 may be lines, grooves, dots or the like which extend completely or partially across the top face 13 at the horizontal midpoint of the head 10. Markers 25, 26 identify the horizontal midpoint of the striking face and extend in opposite directions from the geometric center of the putter head 10. Markers 25, 26 thus serve to align the ball and the putter head 10 with the desired direction of travel as in conventional putters.

**REMARKS**

The specification has been amended to correct typographical errors. It is respectfully requested that this amendment be entered. An early action to that effect is earnestly solicited.

In the event a telephone conference could resolve any outstanding issue, a call to the undersigned is invited.

Respectfully submitted,



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September 13, 2005

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